Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL C. ROBBINS

Appeal No. 1999-0564
Application 08/398,834

ON BRIEF

Before THOMAS, JERRY SMITH and BLANKENSHIP, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 2-11, 13 and 22-31. Claims 1, 12, 14-21 and 32 had previously been cancelled. Claim 33 was indicated by the examiner to contain allowable subject matter. Appellant indicates that claims 6-11, 23-25 and 29-31 are not being appealed [brief, page 2]. Therefore,

this appeal is directed to the rejection of claims 2-5, 13, 22 and 26-28.

The disclosed invention pertains to an input device for a computer. More specifically, the input device has a keyboard with two sets of keys spaced apart from each other. A touch sensitive pad is disposed in the space between the two sets of keys. The input device is designed so that the operator can operate the touch sensitive pad with an index finger while keeping the other fingers on the traditional home keys of the keyboard.

Representative claim 2 is reproduced as follows:

2. A computer with a central processing unit, a memory, a display and an input device, wherein said input device comprises:

a keyboard having a plurality of keys, each key corresponding to one of a plurality of alphanumeric and punctuation characters, said keys arranged in first and second sets, each set having a plurality of rows, each set having a home row of keys for normally receiving the tips of the fingers of an operator, said first and second sets spaced from each other, said keyboard having a switching matrix operatively associated with said keys for generating a computer input signal corresponding to the key operated by an operator; and

a touch sensitive input pad disposed in the space between the two sets of keys and accessible by removing only one index finger from one of the home keys,

wherein the touch sensitive input pad generates one or more signals corresponding to one or more different pressures applied to on the pad by the operator.

The examiner relies on the following references:

Bowen 5,502,460 Mar. 26, 1996 (filed Aug. 02, 1994)

"Combined-User Interface for Computers, Television, Video Recorders, and Telephone, etc.," IBM Technical Disclosure Bulletin, Vol. 33, No. 3B, August 1990, pages 116-118 (hereinafter IBM).

Claims 2-5, 13, 22 and 26-28 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Bowen in view of IBM.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's

rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 2-5, 13, 22 and 26-28. Accordingly, we affirm.

Appellant has indicated that for purposes of this appeal the claims will all stand or fall together as a single group [brief, page 8]. Consistent with this indication appellant has made no separate arguments with respect to any of the claims on appeal. Accordingly, all the claims before us will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against independent claim 2 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine,

837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument

and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

With respect to representative, independent claim 2, the examiner cites Bowen as teaching a computer in which two separate sets of keys [80,86] are spaced apart with a touch sensitive display [84] disposed therebetween. The examiner cites IBM as teaching a touch sensitive input pad in which two different pressures are detected for moving a cursor and for selecting a function, respectively. The examiner finds that it would have been obvious to the artisan to modify the touch sensitive display of Bowen to be responsive to two different pressures as taught by IBM [answer, pages 4-5].

Appellant’s only argument is that the modification

proposed by the examiner is improper because it would eliminate the display from the Bowen computer, making it inoperable for its intended purpose [brief, pages 9-10].

We agree with the position argued by the examiner. As pointed out by the examiner, the proposed modification does not replace Bowen's display with a touch sensitive pad because Bowen discloses that display 84 may also be a touch sensitive display [column 7, line 14]. Therefore, all the examiner proposes to do is modify the touch sensitive display of Bowen to respond to pressure as taught by IBM. Under this modification, the Bowen computer would still operate for its intended purpose.

In summary, the examiner has established a prima facie case of the obviousness of representative claim 2. Appellant's only argument in rebuttal is not agreed with and is not persuasive of error in the rejection. Therefore, we sustain the examiner's rejection of all the appealed claims. Accordingly, the decision of the examiner rejecting claims 2-5, 13, 22 and 26-28 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR

§ 1.136(a).

AFFIRMED

JAMES D. THOMAS Administrative Patent Judge	)	
JERRY SMITH Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
HOWARD B. BLANKENSHIP Administrative Patent Judge	)	

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